

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Title: HIGH INDEX AND HIGH IMPACT RESISTANT POLYTHIOURETHANE/UREA
MATERIAL, METHOD OF MANUFACTURING SAME AND ITS USE IN THE
OPTICAL FIELD

Appl. No.: 09/992,054

Applicants: Jallouli *et al.*

Filed: November 14, 2001

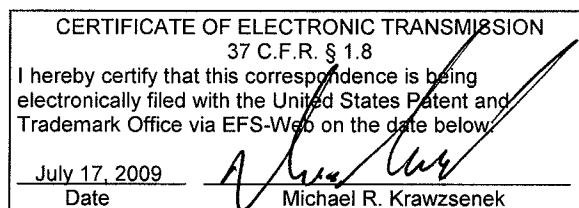
TC/A.U.: 1796

Examiner: Sergent, Rabon A

Docket No.: ESSR:058US

Customer No.: 32425

Confirmation No. 4850



**RESPONSE TO NOTICE OF
NON-COMPLIANT AMENDMENT MAILED JULY 6, 2009**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant submits this Response to the Notice of Non-Compliant Amendment mailed July 6, 2009. No fees are believed due in connection with this filing. However, should any fees be due; the Commissioner is authorized to deduct any such fees required under 37 C.F.R. §§ 1.16 to 1.21 from Fulbright & Jaworski Deposit Account No. 50-1212/ESSR:058US.

The Examiner takes the position that Applicant's response filed March 18, 2009 (which is incorporated by reference into this response) "fails to discuss or adequately address the Bertozzi

reference” with respect to paragraphs 3 and 4 of the December 17, 2008 Office Action. Applicant wholeheartedly disagrees.

The primary references used to support the two obviousness rejections are WO 01/36507 and WO 01/36508. These references have essentially the same disclosure. Therefore, Applicant’s detailed arguments and comments presented against Bertozzi on pages 16-20 of its March 18, 2009 response equally apply to both obviousness rejections. Indeed, how could the following argument made Applicant not apply to all of the obviousness rejections which rely on Bertozzi:

Teaching Away. Bertozzi teaches that the polythiol reactants disclosed may be used to produce elastomeric properties (col. 1, l. 41-42). Consequently, Bertozzi teaches away from the claimed invention. A “reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the Appellant.” *Tec Air Inc. v. Denso Mfg. Michigan Inc.*, 192 F.3d 1353, 1360 (Fed. Cir. 1999).

The teachings of Bertozzi would lead a person of ordinary skill in the art away from producing a material suitable to the ophthalmic lens industry, where elastomeric materials are *not* acceptable. The fact that Bertozzi teaches away from the claimed invention is a significant factor to be considered in determining obviousness. *In re Gurley*, 27 F.3d 551, 554 (Fed. Cir. 1994); *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983); MPEP § 2145[X](D)(2).

Bertozzi teaches away from the present invention in at least another respect, since the better properties are obtained in Bertozzi by oxidative coupling of the polythiols polymers, which leads to the formation of disulfide linkage (col. 8, l. 10-20 and col. 9, l. 59-63). These teachings contradict those of the present invention (see Table VII in the present specification).

March 18, 2009 Response at pages 18-19 (emphasis in original). The fact that a reference teaches away from the claimed invention applies to that reference irrespective as to whether the comment is made in the context of a particular rejection. Stated another way, the above argument is saying that it is improper to use Bertozzi to support any rejection, as it teaches away from the claimed invention. That is, Bertozzi does not cure either the ‘507 nor the ‘508 cited art deficiencies.

Further, Applicant's conclusion in its March 18 response explains that Bertozzi cannot cure the deficiencies of either the '507 nor the '508 cited art:

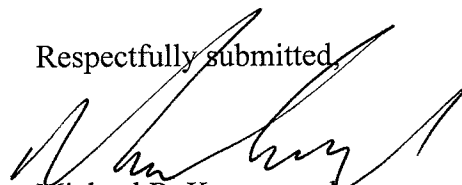
Summary. As is evident from the preceding, the '508 application and Bertozzi cannot cure *any* of the deficiencies set forth above with respect to the '507 application and Saegebarth. Thus, for the same reasons that the '507 application and Saegebarth were unable to obviate the claimed invention, so too are the '508 application and Bertozzi (or Saegebarth). Reconsideration and withdrawal of this cumulative rejection is therefore requested.

Page 20 (emphasis in original). The above conclusion addresses the '507 reference in combination with either Saegebarth or Bertozzi.

In an effort to move the prosecution of this case forward, however, Applicant incorporates all of the comments made at pages 16-20 concerning Bertozzi of the March 18, 2009 response into pages 9-15 of the same response. This incorporation by reference is appropriate given the fact that the '507 and '508 primary references are essentially identical, Bertozzi teaches away from the claimed invention, and there is no reasonable expectation of success that the combination of Bertozzi with either '507 or '508 would have worked as alleged by the Examiner (see page 20 of the March 18 Response).

Applicant requests that substantive prosecution continue in this case and that any further delays cease immediately.

Respectfully submitted,



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